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PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES

In re Application of:

Hixon et al.

Serial No.: 09/864,723

Filed: May 23, 2001

For: DIE CUTTING SYSTEM,
COMPONENTS THEREOF, AND
METHODS

Confirmation No.: 2791

Examiner: S. Choi

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APPEAL BRIEF

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Attn: Board of Patent Appeals and Interferences

Sir:

This Appeal Brief is being submitted in the format required by 37 C.F.R. § 41.37(c)(1) in response to the communication dated July 18, 2005. The fee required by 37 C.F.R. § 41.20(b)(2) was paid when the original Appeal Brief was submitted.

I. REAL PARTY IN INTEREST

U.S. Application Serial No. 09/864,723 (hereinafter “the ‘723 Application”), the application at issue in the above-referenced appeal, has been assigned to QuicKutz, Inc., as evidenced by the assignment that has been recorded with the U.S. Patent & Trademark Office (hereinafter “the Office”) at Reel No. 013271, Frame No. 0566. Accordingly, QuicKutz, Inc., is the real party in interest in the above-referenced appeal.

II. RELATED APPEALS AND INTERFERENCES

Neither Appellants nor the undersigned attorney are aware of any action pending before the Board of Patent Appeals and Interferences (hereinafter “the Board”) that would affect or influence the Board’s decision in the above-referenced appeal.

III. STATUS OF CLAIMS

Claims 12-16 and 24-37 are currently pending and under consideration in the above-referenced application.

Claims 1-11 and 17-23 were withdrawn from consideration and canceled, without prejudice or disclaimer, pursuant to elections made in response to restriction and species election requirements.

Claims 12-16 and 24-37 are subject to final rejections, which are to be reviewed in the above-referenced appeal.

IV. STATUS OF AMENDMENTS

The '723 Application was filed on May 23, 2001, with twenty-three (23) claims.

On October 8, 2002, a non-meritorious action that included restriction and species election requirements was mailed. A response to that action was filed on November 12, 2002, and included an election to prosecute the subject matter to which claims 12-16 were drawn.

A first action on the merits of claims 12-16 followed on January 31, 2003. In that action, the Examiner rejected each of claims 12-16. Appellants responded to the rejections that were presented in the January 31, 2003, action by filing an Amendment, in which claim revisions were presented along with explanations as to the patentability of the pending claims.

The claim revisions and accompanying remarks were apparently persuasive, as the Examiner asserted new grounds against the pending claims in a Final Office Action dated August 8, 2003. In response, Appellants provided additional reasoning as to the patentability of the pending claims. The Examiner was not persuaded by Appellants' reasoning, as evidenced by the remarks that accompanied the Advisory Action of October 24, 2003.

In view of the finality of the Examiner's claim rejections, a Request for Continued Examination (RCE) was filed on November 10, 2003.

The Examiner promptly issued another final office action on December 15, 2003, and reasserted his prior grounds for rejecting claims 12-16. The final office action of December 15, 2003, was followed on April 15, 2004, by an Amendment Under 37 C.F.R. § 1.116, in which additional claim revisions were presented, as were explanations as to the patentability of the claims over the art upon which the Examiner's rejections were based. In

addition, new claims 24-37 were presented. The Amendment Under 37 C.F.R. § 1.116 was accompanied by another RCE.

In the hope of expediting the process to obtain patentable claims, Appellants participated in an interview with the Examiner on June 15, 2004. Although no specific agreements were reached during that interview, Appellants felt that they had a good understanding of the Examiner's understanding of the art of record and that the Examiner had provided them with useful guidance on how to obtain a patent from the above-referenced application.

Shortly after the interview, on July 9, 2004, another office action was mailed. The Examiner again presented new grounds of rejection against all of the pending claims. Appellants responded on September 13, 2004, with another Amendment and further explanations as to the patentability of the claims, only to be met by many of the same claim rejections in a Final Office Action dated December 13, 2004.

In view of the lack of progress toward identifying patentable subject matter, a Notice of Appeal was filed in the above-referenced application on March 14, 2005. The Notice of Appeal is followed by this Appeal Brief, which is being filed within two months of the Notice of Appeal.

No amendments have been made in the above-referenced application since the Amendment of September 13, 2004.

V. SUMMARY OF CLAIMED SUBJECT MATTER

The reference characters and citations provided herein are merely intended to provide examples of the elements of the claims of the '723 Application in accordance with 37 C.F.R. § 41.37(c)(1)(v), and should not be construed as limiting the scope of any of the claims.

The claims of the '723 Application are directed to apparatus 10, 10' for forcing a die 60 into a sheet 100 of material and which include more than one handle 42, 44, 42', 44'. *See, e.g.*, FIG. 3; paragraph [0038]. A first member 20, 20' of such an apparatus 10, 10', which is associated with one of the handles 42, 42', is configured to receive a die 60. *See* claims 12, 25, and 31; *see also, e.g.*, FIGs. 3, 4, and 5; paragraphs [0039] through [0041]. A second member 30, 30' of such an apparatus 10, 10', which is associated with another of the handles 44, 44', is configured to support a sheet 100 of material, such as paper. *See* claims 12, 25, and 31; *see also, e.g.*, FIGs. 5 through 7; paragraph [0045]. A sheet supporting surface 32, 32' of the second member 30, 30' is oriented to oppose a die receiving surface 22, 22' of the first member 20, 20'. *See, e.g.*, FIGs. 5 and 6, *See, e.g., id.* The handles 42 and 44, 42' and 44' facilitate movement of the opposed surfaces 22, 22' and 32, 32' of the first 20, 20' and second 30, 30' members toward and away from one another. *See* claims 12, 23, and 31; *see also, e.g.*, FIGs. 3 and 8; paragraphs [0048] and [0049].

In claim 12, the first member 20, 20' of the apparatus 10, 10' includes an uninterrupted, planar surface 22, 22' for receiving a die 60. *See, e.g.*, FIGs. 3A, 4, and 5; paragraphs [0040] and [0041]. The sheet receiving surface 32, 32' of the second member 30, 30' of that apparatus 10, 10' is also uninterrupted and planar. *See, e.g.*, paragraph [0045].

The first member 20, 20' of the apparatus 10, 10' of claim 25 includes an unbounded surface 22, 22' for supporting the entire planar back side 64 of a substantially planar die 60. *See, e.g.*, FIGs. 3A, 4, and 5; paragraph [0041].

Like claim 12, the first member 20, 20' of the apparatus 10, 10' of claim 31 includes an uninterrupted, planar surface 22, 22' for receiving a die 60. The second member 30, 30' of the apparatus 10, 10' of claim 31 need not be planar or uninterrupted, however.

VI. GROUND OF REJECTION TO BE REVIEWED ON APPEAL

(A) Claims 12, 13, 16, and 24 stand rejected under 35 U.S.C. § 102(b) for being drawn to subject matter which is allegedly anticipated by the subject matter described in U.S. Patent 5,617,785 to Lo (hereinafter "Lo").

(B) Claims 31, 32, and 37 are rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by the disclosure of U.S. Patent 3,372,482 to Mercorelli (hereinafter "Mercorelli").

(C) Claims 31-34, 36, and 37 have been rejected under 35 U.S.C. § 102(b) for being directed to subject matter that is assertedly anticipated by the subject matter described in PCT International Patent Application Publication WO 00/51533 of Andersen (hereinafter "Andersen").

(D) Claim 14 stands rejected under 35 U.S.C. § 103(a) for being directed to subject matter which is purportedly unpatentable over the subject matter taught in Lo, in view of teachings from U.S. Patent 4,574,693 to Fink et al. (hereinafter "Fink").

(E) Claims 15 and 29 are rejected under 35 U.S.C. § 103(a) for reciting subject matter which is purportedly unpatentable over the teachings of Lo, in view of teachings from U.S. Patent 5,172,622 to Sabin (hereinafter "Sabin").

(F) Claims 25-28 and 30 have been rejected under 35 U.S.C. § 103(a) for being drawn to subject matter that is assertedly unpatentable over the teachings of Lo.

(G) Claim 35 stands rejected under 35 U.S.C. § 103(a) for reciting subject matter that is allegedly unpatentable over teachings from Andersen, in view of the subject matter taught in U.S. Patent 5,660,105 to Benson et al. (hereinafter “Benson”).

VIII. ARGUMENT

A. REJECTIONS UNDER 35 U.S.C. § 102

Each of claims 12, 13, 16, 24, 31-34, 36, and 37 stands rejected under 35 U.S.C. § 102(b).

1. LEGAL AUTHORITY

A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single reference which qualifies as prior art under 35 U.S.C. § 102. *Verdegaal Brothers v. Union Oil Co. of California*, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987). The identical invention must be shown in as complete detail as is contained in the claim. *Richardson v. Suzuki Motor Co.*, 9 USPQ2d 1913, 1920 (Fed. Cir. 1989).

2. REFERENCES RELIED UPON

Lo

Lo describes a table top embossing apparatus that may be manually or automatically operated. The embossing apparatus of Lo includes two magnets 40 and 60 for receiving the members 80 and 90 of an embossing die pair. *See* FIGs. 5 and 6. The magnet 40 and 60 have

opposed surfaces that appear to include protruding, substantially planar central sections. *See id.* Movement of the lower magnet 60 toward the upper magnet 40 may be effected automatically with a motor 71-driven transmission 70 and a variety of associated elements, including spindles 72, 75 and gears 73, 74. Col. 3, lines 1-23; FIGs. 5 and 6. Movement of the upper magnet 40 toward the lower magnet 60 may be effected manually, by use of a gear 56 or a single handle 120. Col. 3, lines 24-45; FIGs. 5 and 6.

Mercorelli

The apparatus described in Mercorelli includes a pair of handles 14 and 15 and two opposable members 11 and 12. FIGs. 1 and 2; col. 1, lines 54-60. The opposable members 11 and 12 are configured to respectively receive complementary male and female dies 21 and 20. FIGs. 1 and 2; col. 1, lines 59 and 60. The opposable members 11 and 12 receive the dies 21 and 20 within undercut channels 18 and 19, respectively. *Id.* While Mercorelli is largely silent as to the configurations of the undercut channels 18 and 19, Mercorelli does explain that each channel 18, 19 includes a number of small bosses 25, “which are locating means for positioning the dies and holding them at the end of the channels 18 and 19.” Col. 1, lines 69-71. Mercorelli describes the bosses 25 as “hemispherical domes.” Col. 1, line 71, to col. 2, line 1.

Andersen

Andersen discloses a tool for punching holes in a skin protection plate for use with a stoma bag. The cutting tool 10 of Andersen includes two handles 20 that are associated with members 14 that may be moved toward and away from one another. Neither of these

members 14 includes an uninterrupted, planar surface. Instead, one of the members 14 includes an opening 38 that receives a bolt 32 protruding from the back side of a holding-up plate 18, which is configured to support a skin protection plate as a hole is formed therein. *See* page 7, lines 8-21; page 9, lines 7-16; FIG. 5. The other of the members 14 includes a small protrusion that is configured to be received within a complementarily configured receptacle in the back side of a hole socket 16 with a cutting/punching edge 22 protruding from the front side thereof. *See* FIGs. 1-4; *see also* page 7, lines 8-24.

3. ANALYSIS

a. LO

Claims 12, 13, 16, and 24 stand rejected under 35 U.S.C. § 102(b) for being drawn to subject matter which is allegedly anticipated by the subject matter described in Lo.

Independent claim 12 recites an apparatus for forcing a die into a sheet of material. The apparatus of independent claim 12 includes first and second members and handles that are associated with the first and second members. The first member includes a die receiving surface, while the second member includes a planar, uninterrupted sheet supporting surface oriented to oppose the die receiving surface. The sheet supporting surface of the second member is uninterrupted and planar.

It is respectfully submitted that Lo does not anticipate at least three elements of independent claim 12.

First, Lo lacks any express or inherent description that either the upper magnet 40 or the lower magnet 60 thereof includes a surface that supports a sheet of material into which a die is to

be forced. Rather, the description of Lo is limited to magnets 40 and 60 with surfaces that are respectively configured to engage a top die 80 and a bottom die 90, which are complementarily configured members of an embossing die pair. *See* FIG. 5; col. 3, lines 11-14.

Second, Lo neither expressly nor inherently describes that the apparatus disclosed therein includes handles associated with first and second members. Although the Examiner has asserted that the frame 30 of the table top embossing apparatus of Lo may be held by the hand of a user (Final Office Action of December 13, 2004, page 6), Lo does not expressly state that the frame 30 of the disclosed apparatus may be used as a handle. Moreover, as the table top embossing apparatus of Lo may be operated without a user holding onto the frame 30, Lo does not inherently describe that the frame 30 comprises a second handle of that apparatus. Instead, Lo merely describes that a single handle 120 is associated with the upper, first magnet 40 of the disclosed apparatus.

Third, Lo includes no express or inherent description that the apparatus thereof includes a planar sheet supporting surface that is oriented to oppose a die receiving surface. Rather, in the device of Lo, a sheet is supported by an embossing die 90, which is certainly not planar.

As Lo does not expressly or inherently describe an apparatus which includes, in identical detail to that recited in independent claim 12, each and every element of independent claim 12, it is respectfully submitted that the subject matter recited in independent claim 12 is not anticipated by the disclosure of Lo under 35 U.S.C. § 102(b).

Claims 13, 16, and 24 are each allowable, among other reasons, for depending either directly or indirectly from claim 12, which is allowable.

Claim 16 is further allowable since, in addition to lacking any express or inherent description of an apparatus that includes more than one handle, Lo lacks any express or inherent description that the table top embossing apparatus disclosed therein includes more than one handle that may be configured to be held and operated with a single hand.

b. MERCORELLI

Claims 31, 32, and 37 are rejected under 35 U.S.C. § 102(b) for reciting subject matter which is purportedly anticipated by the disclosure of Mercorelli.

Independent claim 31 is also drawn to an apparatus for forcing a die into a sheet of material. The apparatus of independent claim 31 also includes first and second members and handles that are associated with the first and second members. The first member includes a planar die receiving surface and a die retaining element associated therewith. The second member includes a sheet supporting surface oriented to oppose the die receiving surface of the first member.

It is respectfully submitted that Mercorelli does not anticipate at least two elements of independent claim 31.

First, Mercorelli does not expressly or inherently describe that the apparatus disclosed therein includes a member with a sheet supporting surface. Rather, the opposable members 11 and 12 of the apparatus described in Mercorelli are both configured to receive dies. FIGs. 1 and 2; col. 1, lines 59 and 60. Thus, the apparatus disclosed in Mercorelli includes two opposable die cutting surfaces.

Second, Mercorelli includes no express or inherent description of a die receiving surface that is planar and uninterrupted. Instead, the description of Mercorelli is quite clearly limited to die receiving surfaces that include hemispherically shaped bosses 25 protruding therefrom. Col. 1, line 68, to col. 2, line 1.

For these reasons, it is respectfully submitted that the disclosure of Mercorelli does not anticipate each and every element of independent claim 31, as would be required to uphold the 35 U.S.C. § 102(b) rejection of independent claim 31.

Claims 32 and 37 are both allowable, among other reasons, for depending directly or indirectly from claim 31, which is allowable.

Claim 32 is additionally allowable since Mercorelli lacks any express or inherent description that the apparatus disclosed therein includes a “die receiving surface . . . configured to receive and completely support an uninterrupted, planar surface of [a] substantially planar die. This is because, as FIGs. 3 and 4 of Mercorelli clearly depict, the dies do not have planar back sides. Instead, as described, the back sides of the dies of Mercorelli must include dimples 24 to receive the bosses 25 that protrude from the die-receiving surfaces of members 11 and 12 and, thus, to hold the dies 21 and 21 in place on their respective members 11 and 12. FIGs. 1-4; col. 1, line 68, to col. 2, line 1.

Moreover, as shown in FIG. 5 of Mercorelli, the male die 21, which is primarily responsible for cutting a sheet of material, includes a raised area 28. Mercorelli emphasizes that the raised area 28 protrude a sufficient distance from a surface of the die 21 to include arcuate edges 8 that may fully engaged by internally confined edges 9 of a corresponding female die 20,

touting this feature as being necessary to avoid the formation of torn or jagged edges along a piece of paper that has been cut by dies 21 and 20. FIGs. 4 and 5; col. 2, lines 11-30.

c. ANDERSEN

Claims 31-34, 36, and 37 have been rejected under 35 U.S.C. § 102(b) for being directed to subject matter that is assertedly anticipated by the subject matter described in Andersen.

Like Mercorelli, Andersen fails to anticipate each and every element of independent claim 31.

In particular, Andersen does not expressly or inherently describe a member that includes an uninterrupted, planar die receiving surface. Instead, the disclosure of Andersen is limited to a member 14 that includes a protruding element that engages a complementary receptacle in the back side of a hole socket 16. *See* FIGs. 1-4.

Furthermore, Andersen neither expressly nor inherently describes a die retaining element that is “configured to secure a substantially planar die to [the] die receiving surface.” As FIGs. 1-4 of Andersen clearly illustrate, the hole socket 16 of Andersen is not substantially planar.

Therefore, Andersen does not anticipate each and every element of independent claim 31, as would be required to uphold the Examiner’s Andersen-based 35 U.S.C. § 102(b) rejection of independent claim 31.

Each of claims 32-34, 36, and 37 is allowable, among other reasons, for depending directly or indirectly from claim 31, which is allowable.

Claim 32 is further allowable since Andersen does not expressly or inherently describe a member 14 with a surface that is configured to “receive and completely support an uninterrupted, planar surface of [a] substantially planar die.” Rather, the disclosure of Andersen is limited to a member that includes a protrusion that is received within a complementary recess that interrupts the planarity of the back side of the hole socket 16 described therein. *See* FIGs. 1-4.

In view of the foregoing, reversal of the 35 U.S.C. § 102(b) rejections of claims 12, 13, 16, 24, 31-34, 36, and 37 is respectfully requested.

B. REJECTIONS UNDER 35 U.S.C. § 103(a)

Claims 14, 15, 25-30, and 35 have been rejected under 35 U.S.C. § 103(a).

1. LEGAL AUTHORITY

The standard for establishing and maintaining a rejection under 35 U.S.C. § 103(a) is set forth in M.P.E.P. § 706.02(j), which provides:

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art, and not based on applicant’s disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991).

2. ADDITIONAL REFERENCES RELIED UPON

Fink

Fink is relied upon for its teaching of mechanical features 76 and 78 for securing an embossing seal to a substantially planar surface of an embossing press. FIG. 3; col. 3, lines 43-46.

Sabin

Sabin teaches a table-top die cutting apparatus 10 that includes a base 20 that is configured to support a sheet of paper or other material to be die-cut, a frame 18 extending upwardly from the base 20 and supporting a die receiving element 14, and a “shifting mechanism” 16 held in place by the frame 18 and associated with the die receiving element 14. Figs. 1 and 4; col. 3, lines 29-39. The shifting mechanism 16 is basically a handle that, when moved, forces the die receiving element 14 downward toward the base 20 of the die cutting apparatus 10 and, thus, forces the cutting edges of a die 12 through a sheet 27 of paper or other material supported by the base. *Id.* In addition, a pad 22 may be located on the base 20. *Id.*

Benson

Benson teaches a punching or embossing tool 10 that includes complementary dies 20 and 22 that are configured to be opposed and biased against one another by compression members 24 and 26. FIG. 1; col. 3, lines 44-48. Each die 20, 22 includes an octagonal base 54, 64 and an octagonal protruding member 50, 60 extending from a substantially planar back side of the octagonal base 54, 64. FIGs. 3 and 4; col. 4, lines 15-44.

Each compression member 24, 26 includes an elongated die receiving cavity 24a, 26a within which a base 54, 64 of a die 20, 22 is to be slidably disposed and retained. FIG. 1; col. 3, lines 49-51. When the base 54, 64 is inserted into the cavity 24a, 26a, the protruding member 50, 60 on the back side of the base 54, 64 of each die 20, 22 extends through a receiving slot 40, which communicates with the cavity 24a, 26a. An end of each receiving slot 40 has a half-octagonal profile 42 which corresponds to the octagonal shape of the protruding member 50, 60 of the die 20, 22 and is, thus, configured to receive a protruding member 50, 60 and retain the same, as well as the die 20, 22, in a desired orientation. FIGs. 3 and 4; col. 4, lines 8 and 9.

A retainer magnet 44 is disposed within each die receiving cavity 24a, 24b to hold a die 20, 22 therein. FIGs. 3 and 4; col. 4, lines 10-44. The retainer magnet 44 also has a half-octagonal profile, which complements the octagonal shape of the base 54, 64 of each die 20, 22. Col. 4, lines 10-14. Each retainer magnet 44, including the magnetic field generated thereby and its half-octagonal profile, in combination with the complementary shapes of the base 54, 64 of each dies 20, 22 and the die receiving cavity 24a, 26a, as well as the complementary shapes of the end of each receiving slot 40 and insertion member 50, 60 of the die 20, 22, holds the die 20, 22 in a desired position within the die receiving cavity 24a, 26a.

3. ANALYSIS

a. LO IN VIEW OF FINK

Claim 14 stands rejected under 35 U.S.C. § 103(a) for being directed to subject matter which is purportedly unpatentable over the subject matter taught in Lo, in view of teachings from Fink.

Claim 14 is allowable, among other reasons, for depending directly from claim 12, which is allowable.

b. LO IN VIEW OF SABIN

Claims 15 and 29 are rejected under 35 U.S.C. § 103(a) for reciting subject matter which is purportedly unpatentable over the teachings of Lo, in view of teachings from Sabin.

Claim 15 is allowable, among other reasons, for depending directly from claim 12, which is allowable.

Claim 29 is allowable, among other reasons, for depending directly from claim 25, which is allowable (*see* the following section).

c. LO

Claims 25-28 and 30 have been rejected under 35 U.S.C. § 103(a) for being drawn to subject matter that is assertedly unpatentable over the teachings of Lo.

Independent claim 25 is directed to an apparatus for forcing a die into a sheet of material. The apparatus of independent claim 25 includes first and second members, as well as handles associated with the first and second members. The first member of the apparatus of independent

claim 25 includes a die receiving surface which is configured to receive and completely support a planar back side of a substantially planar die and a die retaining element associated with the die receiving surface. The second member of the apparatus of independent claim 25 includes a substantially planar sheet supporting surface

It is respectfully submitted that there are a number of reasons that the teachings of Lo do not support a *prima facie* case of obviousness against independent claim 25 or any of claims 26-28 or 30 depending therefrom.

No Motivation to Modify

First, one of ordinary skill in the art would not have been motivated to modify the teachings of Lo, which are drawn to a table top embossing machine that requires cooperating embossing dies and includes only a single handle, in such a way as to develop a two or more handled apparatus that includes a first member for receiving a die and an opposable second member for supporting a sheet of material. In view of the stark differences between the single-handle table top embossing apparatus of Lo and the multi-handle apparatus recited in claims 25-28 and 30, it appears that the only source of motivation for one of ordinary skill in the art to modify the teachings of Lo in the asserted manner would have been the disclosure of the above-referenced application.

Lo Does not Teach or Suggest Each and Every Claim Element

Second, Lo does not teach or suggest several elements of independent claim 25.

Lo either fails to teach or suggest an apparatus with a member that has a die receiving surface which is configured to completely support the back side of the substantially planar die or it fails to teach or suggest an apparatus including a member with a planar die receiving surface. As shown in FIGs. 5 and 6 of Lo, the die-supporting surfaces of both die-receiving magnets 40 and 60 appear to include planar centers that are raised, or stepped, relative to the peripheries of the magnets 40 and 60. Additionally, as shown in FIGs. 5 and 6 of Lo, the upper and lower dies 80 and 90 have much larger diameters than the raised centers of the die-securing surfaces of the magnets 40 and 60, respectively. Consequently, if the back sides of the dies 80 and 90 are planar, they are not fully supported by the planar central portions of the die-securing surfaces of the magnets 40 and 60. Conversely, if the back sides of the dies 80 and 90 are fully supported by the centrally protruding portions of the magnets 40 and 60, the back sides of the dies 80 and 90 would have to include recesses in the back sides thereof and, therefore, the back sides of the dies 80 and 90 could not be planar.

Lo also lacks any teaching or suggestion that either the upper magnet 40 or the lower magnet 60 thereof includes a substantially planar surface that supports a sheet of material into which a die is to be forced. Rather, the description of Lo is limited to magnets 40 and 60 with surfaces that are respectively configured to engage a top die 80 and a bottom die 90; *i.e.*, the members of an embossing die pair. *See* FIG. 5; col. 3, lines 11-14. Thus, the bottom die 90, not a surface of the member to which the bottom die 90 is to be secured, supports a sheet of material. Further, as the bottom die 90 is a member of a pair of embossing dies, the surface of the bottom die 90 that would support a sheet of material is not substantially planar.

Additionally, Lo neither teaches nor suggests that the apparatus thereof includes handles associated with first and second members. Instead, Lo merely describes a single handle 120 that is associated with the upper, first magnet 40 of the disclosed apparatus. While the Examiner has asserted that the frame 30 of the embossing apparatus of Lo may be held by the hand of a user (Final Office Action of December 13, 2004, page 6), Lo does not teach or suggest that the frame 30 may be used as a handle.

Each of claims 26-28 and 30 is allowable, among other reasons, for depending either directly or indirectly from claim 25, which is allowable.

Claim 30 is further allowable since, in addition to lacking any teaching or suggestion of an apparatus that includes more than one handle, Lo lacks any teaching or suggestion that more than one handle of the device described therein may be configured to be held and operated with a single hand.

Secondary Indicia of Nonobviousness

On at least two occasions (in the Amendment Under 37 C.F.R. § 1.116 dated April 15, 2004, and during the interview of June 15, 2004), the Examiner has been informed of the availability of evidence showing secondary indicia of nonobviousness, including commercial success of the apparatus to which claims 25-28 and 30 are drawn. In addition, there has been a long-felt need for a portable press of the type recited in the claims.

A Declaration detailing the commercial success of the claimed apparatus and of the long-felt need for this type of apparatus is included in the EVIDENCE APPENDIX to this Appeal Brief.

As the Declaration and other evidence that has been submitted with the Appeal Brief addresses rejections under 35 U.S.C. § 103(a) that were not raised until the Final Office Action, and this Appeal Brief constitutes the first response to the arguments that were newly presented in the Final Office Action, the Declaration and other evidence that accompanies this Appeal Brief could not have been submitted at an earlier date and, thus, should be considered with the remarks presented in this Brief. 37 C.F.R. §§ 41.33(d)(1) and 41.37(c)(1)(ix).

d. ANDERSEN IN VIEW OF BENSON

Claim 35 stands rejected under 35 U.S.C. § 103(a) for reciting subject matter that is allegedly unpatentable over teachings from Andersen, in view of the subject matter taught in Benson.

Claim 35 is allowable, among other reasons, for depending directly from claim 31, which is allowable.

In view of the foregoing, it is respectfully requested that the 35 U.S.C. § 103(a) rejections of claims 14, 15, 25-30, and 35 be reversed.

VIII. CLAIMS APPENDIX

The current status of each claim that has been introduced into the above-referenced application is set forth in CLAIMS APPENDIX to this Appeal Brief.

IX. EVIDENCE APPENDIX

A DECLARATION OF ERIC J. RUFF is submitted herewith to establish secondary indicia of nonobviousness of the subject matter recited in several claims of the above-referenced application.

X. RELATED PROCEEDINGS APPENDIX

No decisions have been rendered by the Board or any court in a related application. Therefore, this Appeal Brief is not accompanied by a related proceedings appendix.

XI. CONCLUSION

It is respectfully submitted that:

(A) Claims 12, 13, 16, and 24 are allowable under 35 U.S.C. § 102(b) for being drawn to subject matter which is not anticipated by the subject matter described in Lo;

(B) Claims 31, 32, and 37 are allowable under 35 U.S.C. § 102(b) for reciting subject matter that disclosure of Mercorelli does not anticipate;

(C) Under 35 U.S.C. § 102(b), claims 31-34, 36, and 37 are allowable for being directed to subject matter that is not anticipated by the disclosure of Andersen;

(D) Claim 14 is allowable under 35 U.S.C. § 103(a) for reciting subject matter that is patentable over the teachings of Lo and Fink;

(E) Claims 15 and 29 are both allowable under 35 U.S.C. § 103(a) for reciting subject matter which is patentable over the teachings of Lo, in view of teachings from Sabin;

(F) Claims 25-28 and 30 are allowable under 35 U.S.C. § 103(a) for being drawn to subject matter that is patentable over the teachings of Lo; and

(G) Claim 35 is allowable under 35 U.S.C. § 103(a) for reciting subject matter that is patentable over teachings from Andersen, in view of the subject matter taught in Benson.

Accordingly, it is respectfully requested that the rejections of claims 12-16 and 24-37 be reversed and that each of these claims be allowed.

Respectfully submitted,



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Serial No. 09/864,723

CLAIMS APPENDIX

1-11. (Canceled)

12. An apparatus for forcing a die into a sheet of material, comprising:

a first member including:

an uninterrupted, planar die receiving surface; and

a die retaining element associated with said die receiving surface, said die retaining element being configured to secure a planar surface of a substantially planar die to said die receiving surface;

a second member including:

an uninterrupted, planar sheet supporting surface oriented to oppose said die receiving surface; and

handles associated with said first and second members so as to facilitate movement of at least one member of said first and second members toward the other of said first and second members.

13. The apparatus of claim 12, wherein said die retaining element is magnetic.

14. The apparatus of claim 12, wherein said die retaining element mechanically secures a substantially planar die to said die receiving surface.

15. The apparatus of claim 12, wherein said second member includes a cushioning element that forms at least a portion of said substantially planar sheet supporting surface.

16. The apparatus of claim 12, wherein said handles are configured to be held by and operated with a hand of a user.

17-23. (Canceled)

24. The apparatus of claim 13, wherein said die receiving surface is unbounded.

25. An apparatus for forcing a die into a sheet of material, comprising:
a first member including:
an unbounded die receiving surface configured to completely support a planar back side
of a substantially planar die; and
a die retaining element associated with said die receiving surface, said die retaining
element configured to secure the planar back side of the substantially planar die to
said die receiving surface;
a second member including:
a substantially planar sheet supporting surface oriented to oppose said die receiving
surface; and

handles associated with said first and second members so as to facilitate movement of at least one member of said first and second members toward the other of said first and second members.

26. The apparatus of claim 25, wherein the die retaining element comprises at least one of a magnetic and a magnetically-attractable material.

27. The apparatus of claim 26, wherein said die receiving surface is uninterrupted and planar.

28. The apparatus of claim 27, wherein said substantially planar sheet supporting surface is uninterrupted.

29. The apparatus of claim 25, wherein said second member includes a cushioning element that forms at least a portion of said substantially planar sheet supporting surface.

30. The apparatus of claim 25, wherein said handles are configured to be held by and operated with a hand of a user.

31. An apparatus for forcing a die into a sheet of material, comprising:
a first member including:

an uninterrupted, planar die receiving surface; and

a die retaining element associated with said die receiving surface, said die retaining element configured to secure a substantially planar die to said die receiving surface;

a second member including:

a sheet supporting surface oriented to oppose said die receiving surface; and handles associated with said first and second members so as to facilitate movement of both of said first and second members toward each other.

32. The apparatus of claim 31, wherein said die receiving surface is configured to receive and completely support an uninterrupted, planar surface of the substantially planar die.

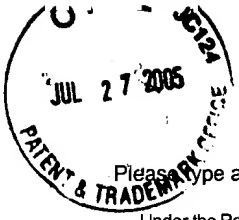
33. The apparatus of claim 31, wherein said die receiving surface is unbounded.

34. The apparatus of claim 31, wherein said sheet supporting surface is uninterrupted and planar.

35. The apparatus of claim 31, wherein the die retaining element comprises at least one of a magnetic and a magnetically-attractable material.

36. The apparatus of claim 31, wherein said second member includes a cushioning element that forms at least a portion of said sheet supporting surface.

37. The apparatus of claim 31, wherein said handles are configured to be held by and operated with a hand of a user.



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TRANSMITTAL FORM

(to be used for all correspondence after initial filing)

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First Named Inventor	Hixon et al.
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Attorney Docket Number	2916-4842US

ENCLOSURES (check all that apply)

- ☒ Postcard receipt acknowledgment (attached to the front of this transmittal)
- ☒ Duplicate copy of this transmittal sheet in the event that additional filing fees are required under 37 C.F.R. § 1.16
- ☐ Preliminary Amendment
- ☐ Response to Restriction Requirement/Election of Species Requirement dated
- ☐ Amendment in response to office action dated
- ☐ Amendment under 37 C.F.R. § 1.116 in response to final office action dated
- ☐ Additional claims fee - Check No. in the amount of \$
- ☐ Letter to Chief Draftsman and copy of FIGS. with changes made in red
- ☐ Transmittal of Formal Drawings
- ☐ Formal Drawings (sheets)

- ☐ Information Disclosure Statement, PTO/SB/08A; ☐ copy of cited references
- ☐ Supplemental Information Disclosure Statement; PTO/SB/08A; copy of cited references and Check No. in the amount of \$180.00
- ☐ Associate Power of Attorney
- ☐ Petition for Extension of Time and Check No. in the amount of \$
- ☐ Petition
- ☒ Appeal Brief (23 pages); Claims Appendix (5 pages)
- ☐ Certified Copy of Priority Document(s)
- ☐ Assignment Papers (for an Application)

- ☐ Terminal Disclaimer
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- ☐ Other Enclosure(s) (please identify below):

Remarks

The Commissioner is authorized to charge any additional fees required but not submitted with any document or request requiring fee payment under 37 C.F.R. §§ 1.16 and 1.17 to Deposit Account 20-1469 during pendency of this application.

SIGNATURE OF APPLICANT, ATTORNEY, OR AGENT

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July 26, 2005

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